



UNITED STATES
PATENT AND
TRADEMARK OFFICE

JUL 23 2001

Docketed: 8/2/01
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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MARSHALL O'TOOLE

AUG 21 2002

OFFICE OF PETITIONS

PETITION under 37 C.F.R. 1.181 & 1.183

In re Application of
McCafferty et al

Serial No.: 09/417,479

Filed: October 13, 1999

Attorney Docket No.: 28110/32729A

This is in response to applicants' petition filed under 37 C.F.R. 1.181 and 1.183 on 29 March 2001, to request that a sequence listing is not required for the present application under MPEP 2421.01. The delay in acting on this petition is regretted.

The petition was filed in response to a Office action Mailed by the examiner dated 28 December 2000, which stated that the application failed to comply with the Sequence Listing requirements of 37 C.F.R. 1.821-1.825. Specially, the application failed to provide an initial computer readable form of the sequence listing and a paper copy of the sequence listing, along with a statement that the contents of the paper copy and computer readable form are the same and no new matter has been added.

Applicant is correct that compliance with the requirements of 37 C.F.R. 1.821-1.825 is not required for the U.S. national stage filing of a PCT application under MPEP 2421.01. The petition also correctly states that Article 27(1) PCT prohibits national law requiring compliance with requirements relating to the form or contents of the international application different from or in addition to those which are provided for in the PCT. Attachment A is a decision on a petition from the 07/971,857 file, which confirms that the national stage filing of that PCT application need not comply with the sequence rules requirement.

A review of the '479 file shows that the instant application was filed as a continuing application under 37 C.F.R. 1.53(b) (Paper No. 2 filed 10/13/99). Further, as the petition correctly states, the instant application is a divisional of 08/484,893, which was a continuation of 07/971,857 which was a U.S. national stage filing of PCT/GB91/01134.

The exemption from filing a sequence listing as discussed in MPEP 2421 is limited to the national stage filing under 37 C.F.R. 371. In the instant application's lineage, that exemption is only granted to the 07/971,857 application which was the national stage filing under 37 C.F.R. 371. Continuations and divisionals of national stage filings are filed under 35 USC 111 are treated as new applications and as such, are required to comply with 37 C.F.R. 1.821-1.825.

Applicant has not demonstrated that the instant application is a national stage filing under 37 C.F.R. 371. Applicants are required to comply with the requirements of 37 C.F.R. 1.821-1.825, as set forth on the letter sent 28 December 2000 as paper no 10. Therefore the petition is DENIED.

Docketed: 8/23/01

APPLICANTS ARE GIVEN A ONE MONTH PERIOD OF TIME FROM THE DATE OF MAILING OF THIS DECISION WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.F.R. 1.821-1.825. Failure to comply with these requirements will result in abandonment of the application under 37 C.F.R. 1.821(g).

Should there be any questions with regard to this letter please contact Julie E. Burke, Ph.D. by letter addressed to the Group Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7939.

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